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| 09/475,912      | 12/30/1999  | PERRY A. PIERCE      | E-925               | 7042             |

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EXAMINER

ZURITA, JAMES H

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3625

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/475,912

Applicant(s)

PIERCE, PERRY A.

Examiner

James Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-7,9-17 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, 9-17, 19-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

In view of the appeal brief filed on 18 June 2003, prosecution is hereby reopened. New grounds for rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (a) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113, if the Office action is final; or
- (b) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits ( §§ 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claims 1, 3-7, 9-17 and 19-24 are pending and will be examined.

### **Response to Arguments**

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., negotiation) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Drawings***

Figures 4-7, filed with the amendment of 22 July 2002 are approved. See also page 4 of Office Action of 13 January 2003.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 14, 15 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant cancelled claims 2, 8 and 18 on 22 July 2002. However, claims 14 and 15 still depend from claim 2. Similarly, claim 9 still depends from claim 8. Claim 19 still depends from claim 18.

Regarding claim 1(c) (ii), the word "means" is preceded by the word(s) " a program" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3-7, 9-17 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (US Patent 5,892,900).

Ginter teaches an interactive networked system connected with repositories of data to store data, information and money information. The data storage stores data concerning items. Information storage stores transaction information such as fees and prices for downloading items. Money information includes data concerning seller and buyer accounts. The system includes program(s) that automatically perform various tasks, including communications and transaction processing. Ginter teaches:

- Storing data items in a data repository. See for example, references to secondary storage, secure databases, other information, Fig. 8 and related text, Col. 62, line 51-Col. 64, line 15.
- Depositing a fund in the data repository; Deducting a monetary sum from the fund; Crediting the deducted monetary sum to a seller. For example, see references to funds transfer system which resolves payments through debits and credits of buyer and sellers and also processes direct debits to bank accounts, Col. 316, lines 53-Col. 317, line 14.
- Downloading a portion of the data item so that a buyer may review a portion of the data item without the possibility of downloading the entire data item without paying the seller. Downloading the data item from the data repository. See, for example, access, Fig. 54 and related text, Col. 198, line 41-Col. 200, line 53.
- Comparing offered price to determine if the offered price falls within a fee range specified by a seller. A buyer is allowed to download the data item if the buyer's

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proposed monetary sum for downloading the item is greater than or equal to a minimum amount. See, for example, references to negotiations, Col. 269, line 15-Col. 278, line 37. See also references to software that automatically compares a buyer's price to determine if the amount is within a range described as acceptable.

- Digital signatures and certification authorities. See, for example, Col. 273, line 40-Col. 274, line 51. See also Col. 225, line 58-Col. 227, line 42.

Ginter does not specifically disclose which programs function to execute intended uses claimed by applicant, "...for posting the fee for downloading the data item from the data storage..." or that one or more programs are capable of

- "...communicating with the data storage, the information storage and the monetary storage so as to store a fund deposited by the buyer to pay for downloading the data item into the buyer's account;
- to allow the buyer to download a portion of the data item so that the buyer may review the data item without the possibility of downloading the data item in its entirety without paying the seller;
- to deduct a monetary sum from the deposited fund according [to] the posted fee in the information storage;
- to allow the buyer to download the data item from the data storage; and
- to credit the monetary sum to the seller's account, wherein the **fee** for downloading the data item has a range specified by the Seller and defined by a maximum amount, and a minimum amount wherein the maximum amount is the

fee posted by the Seller, and a minimum amount is what the Seller is willing to collect from the buyer for downloading the data item so that the buyer is allowed to download the data item if the buyer's proposed monetary sum for downloading the data item is greater or equal to the minimum amount specified by the seller."

However, the specific meaning/interpretation of the data stored in the various storage area does not patentably distinguish the claimed system. Further, the recited statement of intended use, "...for posting the fee for downloading the data item from the data storage..." does not patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any type of queries in the system taught by Reference A because the subjective interpretation of the queries does not patentably distinguish the claimed invention.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8:30 am to 5:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

*JE*  
**James Zurita**  
**Patent Examiner**  
**Art Unit 3625**  
August 25, 2003

  
Jeffrey A. Smith  
Primary Examiner